

REMARKS

Attached hereto is a marked-up version of the changes made to the claims by the above amendment. The attached page is captioned "Version with markings to show changes made."

Claims 1-3 and 13 have been amended to better tailor them for business reasons related to preferred commercial embodiments of the invention. Support for the amendments is provided at least by the claims and specification as originally filed.

New claims 28-33 are dependent from claim 2 and correspond to pending claims 5, 8, 13, 14, 16 and 17.

No new matter has been introduced, and entry is respectfully requested.

Group IV (claims 22-27) have been canceled without prejudice for presentation at a later time. Applicants respectfully traverse the remainder of the Restriction Requirement and submit that the asserted basis for the Restriction are insufficient. Applicants thus request the Restriction be reviewed and modified for the following reasons.

The Examiner has stated that Group I (claims 1, 5-9, and 11-21); Group II (claims 2, 4, and 10); and Group III (claim 3) are distinct because they "differ in the method objectives, method steps and parameters." Applicants note that similar claims in related application 09/556,833 were examined together and respectfully traverse based on the following.

As an initial matter, Applicants note that all three Groups have been classified by the Examiner as belonging to class 514, subclass 1. This is in contrast to the statement in the Restriction Requirement that "examination of all groups would require different searches in the U.S. Patent shoes...." Applicants respectfully point out that there is no search burden present in searching a single class and subclass, which classification also indicates that the U.S. Patent and Office Classification System does not treat the Groups as having attained separate status in the art. The search of each of Groups I, II and III would be identical. Because no burden of search is present in searching a single subclass (in contrast to the requirement for a "serious burden" at

MPEP 803), the reasons for restriction between these Groups are insufficient and the restriction may be properly withdrawn.

Moreover, the rationale presented in support of the above assertion is that the claims of Group I "requires the patient to have a metastatic tumor as opposed to Group III which is a primary tumor that has not metastasized, as opposed to Group II which the patient does not have a tumor." Applicants respectfully submit that the rationale simply does not fit the facts of the claims as presented.

First, the above rationale appears incorrect in asserting that the claims of Groups I and II are unrelated. It is entirely possible that a subject undergoing treatment for existing metastatic tumors (Group I) may also be treated to prevent the development of additional metastatic tumors (Group II). Similarly, the rationale appears incorrect in asserting that the claims of Groups II and III are unrelated. It is entirely possible that a subject undergoing treatment for existing primary tumors (Group III) may also be treated to prevent the development of metastatic tumors (Group II). Applicants thus respectfully submit that the above rationale fails to support the Restriction Requirement.

Moreover, the claims of Groups I, II and III are identically directed to methods comprising one step of administering and a second step of irradiating, with the administered materials being identical in both Groups and the irradiation being with identical light in both Groups. Thus Applicants respectfully submit that the methods differ in "method steps" as asserted in the statement of the Requirement.

Applicants note that the assertion that the Groups differ in "method objectives" suggests that the preamble of claims 1, 2 and 3 may have been relied upon as the basis for the Restriction Requirement. If so, the Examiner is respectfully requested to make this clear on the record that the preamble of the claims have been accorded sufficient patentable weight to warrant the Restriction Requirement. Applicants note, however, that if this is in fact the Examiner's position, the simple deletion of the preamble would obviate the basis for Restriction.

In light of the above, Applicants respectfully submit that the restriction between Groups I, II and III lacks proper support and may be properly withdrawn.

In the event that the instant Restriction Requirement is maintained despite the above discussion, Applicants hereby elect Group II, claims 2, 4, and 10 (as well as new claims 28-33), with traverse for the reasons presented above.

Applicants expressly reserve the right under 35 U.S.C. § 121 to file a divisional application directed to the nonelected subject matter during the pendency of this application, or an application claiming priority from this application.

Applicant requests examination of the elected subject matter on the merits.

In the event that the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 273012011120. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

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Version with markings to show changes made.

Kindly amend the claims as follows:

Please cancel claims 22-27.

Please amend the claims as follows:

1.(amended) A method of treating metastatic tumors in a subject, which method comprises:

administering to a subject afflicted by metastatic tumors effective amounts of one or more green porphyrin photosensitizer and one or more immuno-adjuvant, and

irradiating said subject with light absorbed by said one or more green porphyrin photosensitizer ,

wherein said method is photochemical mediated photodynamic therapy (PDT).

2.(amended) A method of preventing or inhibiting the development of metastatic tumors in a subject, which method comprises:

administering to a subject at risk for developing metastatic tumors effective amounts of one or more green porphyrin photosensitizer and one or more immuno-adjuvant, and

irradiating said subject with light absorbed by said one or more green porphyrin photosensitizer.

3.(amended) A method of treating a primary tumor in a subject, which method comprises:

administering to a subject clinically diagnosed with a primary tumor effective amounts of one or more green porphyrin photosensitizer and one or more immuno-adjuvant, and

irradiating said subject with light absorbed by said one or more green porphyrin photosensitizer.

13.(amended) The method of claim 1 wherein said one or more photosensitizer is a benzoporphyrin derivative (BPD)[or a green porphyrin].